



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/796,030

03/10/2004

Shushi Takiyama

1046.1315

2151

21171 7590 07/08/2008

STAAS & HALSEY LLP

SUITE 700

1201 NEW YORK AVENUE, N.W.

WASHINGTON, DC 20005

EXAMINER

LE, KHANH H

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

07/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/796,030	Applicant(s) TAKIYAMA, SHUSHI	
	Examiner KHANH H. LE	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the correspondence filed 03/24/2008. Claims 1-18 are pending. Claims 1, 6, 11, and 16 are now independent.

Specification

2. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) was required because, the Examiner stated in the last Office Action, that for example, paragraphs [0006]-[0010] and [0033] are incomprehensible and many others are as well.

Applicant made some corrections and dispute that the requirement is proper. However, as shown below, even the submitted corrections are inadequate.

As issues of lack of support arise when the specification is confusing or incomplete or incomprehensible, a requirement for a substitute specification, using proper idiomatic English, is appropriate.

Since the specification is replete with confusing language, examples only, referring to the newly submitted specification paragraphs below, will be herein discussed:

Newly submitted paragraph [0006]:

In the prior art, however, in the case where the information distributor such as the broadcasting station, etc., distributes the information attached with no advertisement but with the charge, even when the user wishes to see the information with free of charge, even if the advertisement is attached to it, the user is unable to receive the information thereof free of charge and to record the information.

“to record the information”: which information is to be recorded? the advertisement information?

Newly submitted paragraph [0007]: *Further, the information distributor such as the broadcasting station, etc., has hitherto distributed an information free of charge by attaching the advertisement to the information, however, there recently increases a case in which the information distributor such as the broadcasting station, etc.. distributes an information with a charge by not attaching the advertisement to it.*

“**recently increases a case**”, in the context, is not idiomatic English and confusing thus incomprehensible; “**the advertisement**” begs the question: which advertisement? does the particular advertisement have any relevance?

Newly submitted paragraph [0009]:

*Further, generally, the information distributor such as the broadcasting station, etc., **adopts any one of the case of** distributing one piece of information as the free-of-charge information with the advertisement information, **and the case of** distributing the information as paid-for information with no advertisement information. The information distributor **does not take such a changeover** that the information with the advertisement information which is distributed as a free-of-charge information **is changed** to the information with no advertisement information which is distributed as a paid-for information.*

“**adopts any one of the case of...and the case of...**” does not mean any case is adopted.

“**the case of distributing one piece of information**”: does that mean only one piece of information is distributed? which piece? How does that relate to “*the information*” in the latter part of the phrase?

“**Changeover**” and “**changed**”: these terms are only used in this paragraph, and paragraph [0010]. Because idiomatic English is not used, the Examiner cannot discern whether this is a feature of the invention, or just superfluous discussion. **In other words, the main inventive features are hard to discern because idiomatic English is not used.** Same issue with “**in a fixed case**” discussed below.

Newly submitted paragraph [0033] :

*In the invention, an advertisement insertion server of a picture/sound recording instruction service provider such as the advertisement agent, etc., transmits to the advertisement insertion terminal of the user .(1) the advertisement information provided by the picture/sound recording instruction service provider such as the advertisement agent, etc., wherein the advertisement information containing multimedia information such as an advertisement moving picture, an advertisement still picture, an advertisement voice, advertisement characters and an advertisement link or an arbitrary combinations thereof and (2) the picture/sound recording instruction information indicating the advertisement information being inserted into the information be distributed, The advertisement information is associated with the picture/sound recording instruction information **in a fixed case**,*

“in a fixed case”: what does this mean?

As corrections to the present specification paragraphs may not clear all issues of indefiniteness (see also 35 U.S.C. 112, second paragraph issues discussion below) or lack of support, or just raise new such issues, a substitute specification is deemed the best solution.

As stated by Applicant, 37 CFR 1.125(a) provides that a substitute specification might be required "[i]f the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application..". Since as shown above, numerous corrections (not just for minor grammar errors as argued, but also to correct meanings in context) may be required, requiring a substitute specification is proper. When filed, it must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6, 11, 16: “records **the** information” is confusing, since as amended , there are several types of information recited, e.g. information distributed by an information distributor, advertisement information, and instruction information. Appropriate correction is required.

All dependent claims are rejected based on their dependencies.

Claims 4, 9, 14 are now made dependent on claims 1, 6, and 11 respectively. However, “*the information recording device*” in claims 4, 9, 14 lacks clear antecedent basis. Is it the same as the “*recording unit*” (in claims 1, 6, and 11 respectively)?

Also, a notification “*showing that the advertisement information **has been inserted** into the information stored on said information recording device and thus recorded*” is confusing since in the independent claims, it is not clear that the advertisement has been positively inserted. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. Previous rejections of claims 11-15 as directed to software per se are withdrawn following corrections.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3688

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-18 are rejected under 35 U.S.C. 102(b)) as being anticipated by Logan et al. US 6199076.

Independent claims 1, 6, 11, 16 and dependent claims 3-4, 8-9, 13-14:

Logan discloses radio or television programming and advertising broadcasted and compressed for local storage (at storage 107 of Figure 1) (col. 6 lines 62-67, col. 5 lines 35-39) based on explicit or implicit user preferences. The resulting programming may then be selected for inclusion in the user's program library and selected for playback under user control. The cost of programming could be financially supported in whole or in part by subscription fees, or by advertising, and users could elect the extent to which they were willing to view advertising in exchange for reduced subscription fees :Ads are inserted at user device (player) automatically based on user predetermined cost control instructions or under specific user control (col. 11 lines 16-37; Figure 3 step 235 and associated text). Specific user experience of the ads is recorded so to provide user discounts as well as billing advertisers (abstract)

Thus Logan discloses:

An advertisement information management system and method comprising:

a) an information recording device (IRD) (user player, Figure 1 item 103) including:
al) record executing unit (and/or associated computer program) (Figure 1 item 105 : CPU and program, col. 11 lines 16-37,) for inserting advertisement information into information (i.e. programming) (and thus recording the information on recording unit) recording the (ads) information in accordance with instruction information (col. 11 lines 16-37; col. 12 lines 28-34. Figure 3 step 235 and associated text)

(Notes on interpretation:

Note #1: in Logan, user player instructions to insert into a server-suggested compilation of segments, e.g. at col. 11 lines 16-37, col. 12 lines 28-34, are interpreted as instructions "indicating whether or not the advertisement information is inserted into the information" This is because each ad segment is specifically identified (Fig 5 and associated text) and has a beginning and end (col. 46 lines 13-27). Thus implicitly Logan's system can detect whether an ad had been inserted and if not, it would be inserted as instructed).

Note #2: This interpretation is consistent with the instant specification because although the phrase " a piece of instruction information indicating whether the advertisement information is inserted into the information or not" (in the ad insertion step) is repeated many times in the specification, it is not explained any further, nor are any details given on how that is achieved. Thus the phrase is reasonably interpreted as a mere instruction to insert the ad into the programming content. Logan discloses that. In other words, on this issue, Logan discloses at least as much as the instant application.

Note #3: the phrase "apiece of instruction information indicating whether the advertisement information is inserted into the information or not" is also reasonably interpreted as a mere instruction to insert because "indicating whether the advertisement information is inserted into the information or not" is just a label for the instruction, which label is non\-\ functional descriptive material and does not affect the step of inserting (nor the device or system performing that step). Therefore the label is given little if any patentable weight. See MPEP 2106.

Also see the following USPTO Board of Appeals and Interferences Informative Decisions for similar analyses:

Ex parte James Prescott Curry,

<http://www.uspto.gov/web/offices/dcom/bpai/its/fdO50509.pdf>

Art Unit: 3688

Ex Parte Herman Mathias, <http://www.uspto.gov/web/offices/dcom/bpai/its/fd051851.pdf>, (affirming a 35 USC section 102 rejection) (also affirmed at the CAFC (August 17, 2006)).

and

a2) notifying unit (Figure 1 item 109, usage log and associated applications) notifying an advertisement information management device (IRMD) (for managing a user) (server 101 which contains user usage and data log 143 is interpreted as such a device, see Figure 1 and associated text) that the advertisement information has been inserted into the information and thus recorded on said recording unit (see e.g. col. 12 lines 58-67: ads display to user is monitored and reported to server 101),

and

b) an advertisement information management device (AIMD) (server 101 which contains user usage and data log 143) including:

b 1) receiving unit receiving the notification (Fig 1 item 143);

and

b2) advertisement information management unit updating data about the advertisement information on the basis of a content of the notification (Fig 1 item 143; updating data for billing, see abstract).

Claims 2, 7, 12, 17:

Logan discloses the system, method or computer program of claims 1, 6, 11 or 16 above and further discloses:

wherein said IRD (user player) further includes

instruction information generating unit or program generating

the instruction information (col. 11 lines 16-37; Figure 3 step 235 and associated text).

Claims 5, 10, 15 and 18:

Logan discloses the system, method or computer program of claims 4, 11, 14 or 16 above and further discloses:

wherein said AIMD (server 101) further includes instruction information generating unit (e.g. Figure 1 item 151: download processing unit) generating the instruction information (col. 8 lines 39-44);

(**Note:** Logan's server side instructions to insert particular ads into a compilation of programs and ads (col. 9 lines 25-29) to be sent to user and which would execute according to the server-generated sequence unless the user intervenes by editing, reads on "generating instruction information", (col. 8 lines 45-63). These instructions to insert according to a particular sequence (see Figure 5 and associated text) are also interpreted as instructions "indicating whether or not the advertisement information is inserted into the information" so to effect a particular sequence of insertions. This is inherent because each ad segment is specifically identified (see Figure 5 and associated text) and sequenced with a beginning and end (col. 46 lines 13-27; Fig 5). Note also that interpretation notes #2 and #3 discussed at page 4 above also apply here). and an instruction information transmitting unit (communications modules items 125 to storage 107 of Figure 1) transmitting the instruction information (e.g. sequence of replaying segments) to said information recording device used by the user (see Figure 1 and associated text).

Response to Arguments

8. Applicant's arguments have been fully considered but they are not persuasive. The following is an integral part of the grounds of rejection.

Applicant argues that Logan does not disclose a picture/sound recording instruction service provider who is selected by the user and has independently prepared the advertisement information. In other words, Applicant argues Logan does not disclose a picture/sound recording instruction service provider which is different from the information distributor and which is selected by the user.

However such feature does not have patentable weight as explained below.

Current Claim I recites:

An information recording device for recording ~~received~~ information which is distributed by an information distributor and is received by a user, comprising:
a record executing unit inserting which receives advertisement information showing an advertisement having a content prepared independently by a picture/sound recording instruction service provider who is selected by the user and inserts the advertisement information into the information distributed by the information distributor in accordance with a piece of instruction information indicating whether the advertisement information is inserted into the information or not, and ~~records~~ the information on a recording unit.

However the status of the content of the ad as “showing an advertisement having a content prepared independently by a picture/sound recording instruction service provider who is selected by the user” **does not affect the structure or functionality of the record executing unit**, which is just to receive some advertisement and then to insert such ad into some other information (which could be broadcasting content).

Art Unit: 3688

By the same token, the qualification of the information received in the preamble, as “*which is distributed by an information distributor and is received by a user*” does not add nor subtract anything to the device.

In other words, for prior art application purposes, current independent claim 1 is equivalent to previously presented claim 1. Thus Logan still anticipates current claim 1.

By the same token current independent apparatus or system claims 11 and 16, are equivalent to previously presented claims 11 and 16 and thus still anticipated by Logan.

As to current independent method claim 6, it recites:

An information recording method of recording ~~received~~ information which is distributed by an information distributor and is received by a user, the method comprising:
receiving advertisement information showing an advertisement having a content prepared independently by a picture/sound recording instruction service provider who is selected by the user;
inserting the advertisement information into the information distributed by the information distributor in accordance with a piece of instruction information indicating whether the advertisement information is inserted into the information or not; and
recording the information on a recording unit.

However the status of the content of the ad as “*showing an advertisement having a content prepared independently by a picture/sound recording instruction service provider who is selected by the user*” **does not affect the step of receiving**, thus is not given patentable weight.

Further, “*selected by the user*” is not a positively recited step thus is not given patentable weight.

Also, as in claims 1, 11, 16, information “which is distributed by an information distributor and is received by a user” does not add anything to previously presented claim 6, for art application purposes. Thus in sum, Logan still anticipates current claim 6.

Thus the above rejection, presented in the last Office Action, still applies to the present claims.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday, Wednesday, and Friday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)..

Art Unit: 3688

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

July 5, 2008

/Khanh H. Le/

Examiner, Art Unit 3688

/James W Myhre/

Supervisory Patent Examiner, Art Unit 3688